

**REMARKS**

Reconsideration of this application, in view of the foregoing amendment and the following remarks, is respectfully requested.

Claims 1-5 were originally presented for consideration in this application. Claims 6-10 were added by preliminary amendment. Claims 5 and 9 have previously been canceled without prejudice or disclaimer. Claims 11-13 have been added above. Accordingly, claims 1-4, 6-8 and 10-13 are currently pending in this application.

The following rejections were set forth in the Office Action dated March 11, 2008:

1. Claims 1-4, 6-8 and 10 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,173,788 to Lembcke et al. in view of U.S. Patent No. 5,195,583 to Toon et al.

Regarding the obviousness rejections, the applicant respectfully traverses the rejections. It is important to understand what is disclosed by the Lembcke reference. This reference describes a conventional (longitudinally compressible) packer in which a groove is provided on an outer surface of a seal element 12 to accommodate a cable (see FIG. 1). When the seal element 12 is longitudinally compressed, the cable is sealed against by the seal element (see FIG. 2). However, the reference also mentions several other possible configurations of the seal element (col. 2, lines 51-57): a longitudinal bore can be used instead of a groove, the seal element can have a section left out to accommodate the cable, and the seal element can be made up of a plurality of segments with longitudinal splits for insertion of the cable therein.

It should also be appreciated that a significant problem exists with securing a cable in an opening formed through a seal element which is thereafter longitudinally compressed. As the seal element is longitudinally compressed, it will no doubt grip the

cable and tend to longitudinally compress the cable. After all, it is intended for the seal element to seal against the cable, and so gripping engagement between the seal element and the cable is to be expected when the seal element is compressed.

The examples described in the present specification uniquely solve this problem by utilizing a swellable seal element instead of a longitudinally compressible seal element. As the swellable seal element swells, it seals against the cable without also longitudinally compressing the cable. Such longitudinal compression could be especially hazardous if, for example, the cable is a fiber optic cable or a hydraulic control line. The examples described in the present specification eliminate this hazardous condition.

The Toon patent describes a swellable packer. It would not be obvious to combine the teachings of the Lembcke and Toon patents to produce the invention recited in either of independent claims 1 and 6. There is no objective reason why a person skilled in the art would incorporate the swellable seal material described by Toon into the packer described by Lembcke. For example, this combination would still suffer from the problem of longitudinally compressing the cable.

Thus, the rejections do not satisfy the requirements set forth in the seminal U.S. Supreme Court case of *Graham v. John Deere* for evaluating whether an invention would have been obvious to a person of ordinary skill in the art at the time the invention was made. These requirements include determining the level of skill of the person having ordinary skill in the art, the scope and content of the prior art, and the differences between the claimed invention and the prior art. Additional considerations may include factors such as failure of others to solve the relevant problem, long felt but unsatisfied need, skepticism of others, teaching away in the prior art, unexpected results, copying, the pace of innovation in the art, commercial success, etc.

In the present case, the person having ordinary skill in the art would likely have a bachelor's degree in engineering or a related applied science field, and would likely have several years' experience in designing packers for use in subterranean wells. Such a person would be aware of conventional packer seal materials and setting mechanisms.

The scope and content of the prior art have been discussed above. Since the combination of reference teachings would not, at the time the invention was made, have influenced a person of ordinary skill in the art to use the swellable seal material of Toon in the packer of Lembcke, the claims are not obvious over these references. Withdrawal of the rejections is respectfully requested.

The added claims 11-13 recite a method described in the specification wherein the cable is installed in the longitudinal opening in the packer by inserting it through a slit extending between the opening and an external surface of the packer. The seal material then swells and seals about the cable in the opening. Support for the recited limitations is found in paragraphs 0013, 0015, 0024, 0029 and 0030 of the published application. Since none of the cited references describe or suggest the recited method, allowance of claims 11-13 is respectfully requested.

In view of the foregoing amendment and remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 1-4, 6-8 and 10-13 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

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